

B3

said first dimension of the surface layer is about 10-17 cm.

- B4
19. (Once Amended) The support device according to claim [8] 17 wherein said first and second lateral regions of said bridge piece attach to said first and second side pieces using velcro.

Please add and consider the following new claims:

- B5
21. (New) A support device according to claim 1 wherein the center transverse dimension is about 10-17 cm.

22. (New) The support device according to claim 21 wherein the center longitudinal dimension is about 6-14 cm.

- Jul 13*
23. (New) The support device according to claim 10 wherein (the second dimension) is about 6-14 cm.

Remarks

The Office Action mailed April 28, 2000, has been received and carefully reviewed. Reconsideration and withdrawal of the rejections of the claims of the above-identified application is respectfully requested. Claims 1, 8, 10 and 19 have been amended, claim 12 canceled and new claims 21-23 added. Support for all amendments and new claims is found in the specification as originally filed. Accordingly, no new subject matter has been added.

Rejections Under 35 U.S.C. §112, Second Paragraph

The Examiner rejected claims 1-9, 12 and 19 under 35 U.S.C. §112, second paragraph, as being indefinite. Claim 12 has been canceled rendering this rejection moot as applied to this claim. The herein requested amendments to independent claim 1 and dependent claims 8 and 19 are believed to address the remainder of the Examiner's §112 rejections.

With regard to independent claim 1, and claims dependent therefrom, the Examiner stated that there is no antecedent basis for the recitation of "said first transverse axis." In response, Applicants have amended the claim to recite --said center transverse axis--.

With regard to claim 8, the terms "surface layers" and "adhesive layers" have been supplanted with the terms --surface layer-- and --adhesive layer--, respectively.

With regard to the rejection of claim 19, this claim has been amended to recite a dependency from claim 17 rather than claim 8.

In view of the foregoing amendments to the claims, the Examiner's rejections under 35 U.S.C. §112, second paragraph, are believed to be overcome.

Rejections Under 35 U.S.C. §102

The Examiner rejected claims 1-4 and 9-13 under 35 U.S.C. §102 (e) as being anticipated by U.S. Patent No. 5,718,224 issued to Muchin ("Muchin"). This rejection is respectfully traversed. Muchin does not anticipate the present invention.

In support of the anticipation rejection, the Examiner stated:

Muchin discloses in FIG. 10b a nasal dilator having the claimed dimensions as it is basically oval in shape.

Muchin does not anticipate the claimed invention. It is axiomatic to patent law that a claim is anticipated only if each and every element as set forth in the claims is found in a single prior art reference. Each element of independent claim 1 is not found in Muchin. Indeed, Applicants do not claim something that is "basically oval in shape." Rather, claim 1, and claims dependent therefrom, specifically recite a structure that is neither taught nor suggested by Muchin. Accordingly, because each and every element set forth in the claims is not found in the prior art, the Examiner's rejection of independent claim 1, under 35 U.S.C. §102(e) is traversed.

With regard to independent claim 10, and claims dependent therefrom, in view of the herein requested amendment to the claim, the Examiner's rejection under 35 U.S.C. §102(e) is overcome. Claim 10 now recites a specific size dimension suitable for a horse. Muchin neither teaches nor suggests a device appropriately sized and configured for a horse as claimed. Accordingly, the Examiner's rejection of independent claim 10, and claims dependent therefrom, under 35 U.S.C. §102(e), are believed to be overcome.

Rejections Under 35 U.S.C. §103

The Examiner rejected dependent claims 5-8 and 14-16 under 35 U.S.C. §103(a) as being unpatentable over Muchin in view of U.S. Patent No. 5,533,499 issued to Johnson ("Johnson"). This rejection is respectfully traversed.

The requirements for establishing a *prima facie* case of obviousness are well known and recited, for example, in the MPEP at §2143:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claims limitations.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must be found in the prior art, not in applicant's disclosure. (Citations omitted)

None of the criteria necessary to establish a *prima facie* case of obviousness are met by the combination suggested by the Examiner. For example, all limitations recited in independent claims 1 and 10, from which claims 5-8 and 14-16 directly or indirectly depend, are not taught or suggested in the prior art cited. Thus, without the need to consider motivation or expectation of success, even if the references are combined as suggested by the Examiner, one does not arrive at the claimed invention. Accordingly, this rejection is respectfully traversed.

The Examiner further rejected claims 17-19 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,890,486 issued to Mitra et al. ("Mitra") This rejection is respectfully traversed. Mitra neither teaches nor suggests the device recited in claims 17-19.

Initially, Applicants note that Mitra fails to teach a multi-component device as claimed. Thus, all elements of the claimed invention are not present in Mitra and thus, there is no *prima facie* case of obviousness. Moreover, not only does Mitra fail to disclose all elements of the claimed invention, Mitra also fails to suggest or motivate the present invention. "Even when obviousness is based on a single prior art reference, there must be a showing of a suggestion or motivation to modify the teachings of that reference." In re Werner Kotzab, 217 F.3d 1365 (Fed. Cir. 2000) citing B.F. Goodrich Co. v. Aircraft Braking Sys. Corp., 72 F.3d 1577 (Fed. Cir. 1996). This the Examiner clearly has not done. Rather, the Examiner's rejection is based on speculation supported by nothing more than the Examiner's personal belief. No prior art reference of record teaches, suggests or motivates a support device as claimed. Accordingly, if the Examiner maintains this rejection, the Examiner is respectfully requested to submit the facts

on which he relies in supporting this rejection in the form of an affidavit as provided for in 37 C.F.R. §1.104(d)(2).

Rejections Under the Judicially Created Doctrine of Double Patenting

The Examiner provisionally rejected claims 1-19 under the judicially created doctrine of obvious-type double patenting over the claims of co-pending U.S. Application Ser. No. 09/018,603. The Examiner stated that the rejection was provisional because the claims of the co-pending application had not yet been patented. However, on March 7, 2000, U.S. Application Serial No. 09/018,603 issued as U.S. Patent No. 6,033,422.

Accordingly, without acquiescing to the rejection, because the term of a patent issuing from the instant application will necessarily expire on the same date as U.S. Patent No. 6,033,422, Applicants provide herewith a Terminal Disclaimer in compliance with 37 C.F.R. §1.312.

Petition for Extension of Time

It is noted that a two-month extension of time is necessary, in order to provide for timeliness of the present response. Request for such an extension is made extending the time for response from July 28, 2000, to September 28, 2000.

Summary

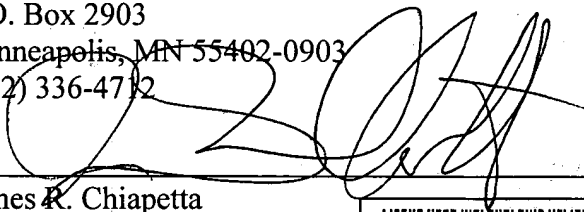
It is respectfully submitted that each of the presently pending claims (claims 1-11, 13-19 and 21-23) are in condition for allowance and notification to that effect is requested.

The Examiner is invited to contact Applicants' representative at the below-listed telephone number, if it is believed that prosecution of this application may be assisted thereby.

Respectfully submitted,

MERCHANT & GOULD P.C.
P.O. Box 2903
Minneapolis, MN 55402-0903
(612) 336-4712

DATE: 9/27/00


James R. Chiapetta
Reg. No. 39,634

